

**REMARKS**

Claims 1-20 remain pending in this application. Further reconsideration of this application is requested.

**The 35 U.S.C § 103 Rejections Are Insufficiently Supported**

The continued rejection of claims 1-3 and 13-19 under 35 U.S.C. § 103(a) as being unpatentable over Thomas (U.S. Patent No. 6,567,101) in view of Silverbrook et al. (U.S. Patent No. 6,405,055) ("Silverbrook"), and of claims 1-20 as being unpatentable over Feinstein (U.S. Patent No. 6,466,198) in view of Thomas and Silverbrook, again are respectfully traversed.

As explained previously, claim 1 sets forth an image capturing device, comprising a display that includes a graphical selection indicator that is capable of being moved in the display, to select from among a plurality of displayed icons. An acceleration sensor detects acceleration motion of the device along at least one axis and generates a responsive acceleration signal, which is used by a processor to move the graphical selection indicator in the display.

Thomas discloses a digital information appliance, such as a wireless phone with integrated organizer or electronic book, which presents information on a display. Thomas discloses that the display of data may be manipulated on the display, such as by moving the data across the screen by scrolling, controlling display of a cursor, or enlarging or reducing the size of the data being displayed. Thomas states at col. 4, ll. 39-46 that the digital appliance may use an accelerometer to detect acceleration of the appliance and therefore rotation of the appliance to control scrolling of text across the display screen.

However, Thomas does not disclose or suggest a display that includes a graphical selection indicator that is capable of being moved in the display, to select from among a plurality of displayed icons, where a signal from an acceleration sensor is used to move the graphical selection indicator in the display.

While the Office action has provided a citation to Thomas to support the assertion that Thomas discloses use of an accelerometer, the Office action provides no citation, and Applicants have found none, that supports the allegation that Thomas discloses "a

processor for receiving the acceleration signal and moving a graphical selection indicator based on the acceleration signal.” In fact, Thomas does not disclose any such processor or display having selectable icons that are selected by a graphical selection indicator. Thomas discloses only the rotation, scrolling, or adjustment of size of displayed text on a display screen. See Figs. 1A-7.

Despite Applicant’s request in the response filed March 8, 2004, the Examiner has failed to provide any citation to Thomas to support the Examiner’s assertion that Thomas discloses “a processor for receiving the acceleration signal and moving a graphical selection indicator based on the acceleration signal.” See Final Office action at 2. Applicant has scoured the Thomas reference and remains unable to find any such disclosure therein. It is respectfully submitted that absent such showing, the rejection does not present a *prima facie* case of unpatentability. See In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (PTO cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims).

The Office action further fails to provide any evidentiary support for its parenthetical interpretation (Final Office action, p. 4) of a cursor as corresponding to the claimed graphical selection indicator “that is capable of being moved in said display to select from among a plurality of displayed icons,” as set forth in the claims. As previously explained (and unrebutted in the Final Office action) a cursor does not constitute a graphical selection indicator for selecting from among a plurality of selectable icons. A cursor instead simply indicates a position on a display screen at which text may be entered using a keyboard. In particular, Webopedia.com defines a cursor as “a special symbol, usually a solid rectangle or a blinking underline character, that signifies where the next character will be displayed on the screen.”

In the Final rejection, the Examiner alleges that Thomas “teaches” an organizer, electronic book or the like, “inherently comprising a graphical user interface which displays a plurality of icons.” To the contrary, Thomas teaches no such device. Thomas instead is directed to a system and method utilizing motion input for manipulating a display of data on a digital information appliance. See col. 1, ll. 6-9. Further, Applicant does not acquiesce in the Examiner’s allegation that the digital information appliance that is the subject of the Thomas disclosure “inherently” includes

a display of selectable icons. A retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination. In re Newell, 891 F.2d 899, 13 USPQ2d 1655 (Fed. Cir.), *cert. denied*, 493 U.S. 814 (1989). Instead, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). On the present record, the Examiner has provided no such factual basis or technical reasoning to support the Examiner's position that a digital information appliance as disclosed by Thomas necessarily includes a graphical selection indicator for selecting from among a plurality of displayed icons.

Similarly, the Final Office action has failed to provide any evidentiary basis to support the position that Thomas teaches substitution of a plurality of acceleration sensors for a computer mouse, for moving a graphical selection indicator. Thomas teaches no such substitution. Thomas instead discloses the use of motion input as an alternative to use of a mouse for manipulating the display of data.

As previously discussed, neither Silverbrook nor Feinstein discloses or suggests use of acceleration sensors to move a graphical selection indicator in order to select a selectable icon in a display space, as taught by the present invention. Accordingly, no combination of Thomas or Silverbrook with Feinstein could result in the claimed invention.

**Conclusion**

In view of the foregoing, claims 1-20 are submitted to be patentable over the prior art of record, whether considered individually or in combination. Further reconsideration of this application, withdrawal of the outstanding grounds of rejection and the issuance of a Notice of Allowance are earnestly solicited.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 08-2025.

RESPECTFULLY SUBMITTED,					
NAME AND REG. NUMBER	Vincent M. DeLuca Attorney for Applicants Registration No. 32,408				
SIGNATURE	Vincent M De Luca			DATE	26 JUL 2004
Address	Rothwell, Figg, Ernst & Manbeck 1425 K Street, N.W., Suite 800				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031